



ATTN. Box Non-Fee Amendment
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

McCall, Catherine A.
Tang, Liang

Serial No.: 09/828,995

Filed: April 9, 2001

Atty. File No.: AL-7

For: "CANINE IL-13 RECEPTOR NUCLEIC
ACID MOLECULES, PROTEINS,
COMPOSITIONS THEREOF AND
METHODS OF USE" (As Amended)

) Group Art Unit: 1647

) Examiner: Spector, Lorraine

AMENDMENT AND RESPONSE

COPY

CERTIFICATE OF MAILING

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ADDRESSED TO BOX NON-FEE AMENDMENT,
COMMISSIONER FOR PATENTS, WASHINGTON, DC
20231, THIS 21ST DAY OF JANUARY 2003.

HESKA CORPORATION
By: Susan A. Gordon
Susan A. Gordon

Box Non-Fee Amendment
Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This response is directed to the Office Action with a mailing date of October 23, 2002. The Applicants would like to thank the Examiner for providing such a well-thought out and well-written review of the above-mentioned Application. Applicants found the guidance provided by the Examiner to be most helpful in their response. Prior to the Examiner's review of the Claims of the above-referenced Application, please enter the following amendments.

IN THE TITLE

Please delete the current title and enter the following new title:

"CANINE IL-13 RECEPTOR NUCLEIC ACID MOLECULES, PROTEINS,
COMPOSITIONS THEREOF AND METHODS OF USE"

IN THE CLAIMS

Please cancel all claims without prejudice or disclaimer of the subject matter therein and enter the following new claims 60-80.



Heska Corporation
Intellectual Property Dept.
1613 Prospect Parkway
Fort Collins, CO 80525

'03FEB 3 RCV'D

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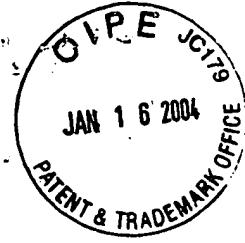


DOCKETED

DATE: January 21, 2003
APPLICANT: Catherine A. McCall; Liang Tang
SERIAL NO.: 09/828,995
ATTY. FILE NO.: AL-7
TITLE: CANINE IL-13 RECEPTOR NUCLEIC
ACID MOLECULES, PROTEINS,
COMPOSITIONS THEREOF AND
METHODS OF USE" (As Amended)

RECEIPT IS HEREBY ACKNOWLEDGED OF:
Amendment and Response; deposited with the
U.S. Postal Service as First Class Mail this date.





**ATTN: Mail Stop ISSUE FEE
PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

) Group Art Unit: 1647

1

McCall, Catherine A.
Tang, Liang

Examiner: Spector, Lorraine

1

Serial No.: 09/828,995

ISSUE AND PUBLICATION FEES
TRANSMITTAL AND REQUEST
FOR CORRECTION TO TITLE

Filed: April 9, 2001

1

Atty. File No.: AL-7

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For: "CANINE IL-13 RECEPTOR NUCLEIC ACID MOLECULES, PROTEINS, COMPOSITIONS THEREOF AND METHODS OF USE"

1

CERTIFICATE OF MAILING

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B

Susan A. Gordon

Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

• Dear Sir:

In response to the Notice of Allowance and Issue Fee Due mailed on October 15, 2003, Applicants submit herewith check no. 067977 in the amount of \$977 in payment of the Issue Fee (\$655), the Publication Fee (\$300) and four (4) advance order copies (\$12). In the event of a deficiency or overpayment in these fees, please debit or credit Deposit Account 081930.

Applicants request the title on the Notice of Allowance and Issue Fee Due be corrected to note the new title: "CANINE IL-13 RECEPTOR NUCLEIC ACID MOLECULES, PROTEINS, COMPOSITIONS THEREOF AND METHODS OF USE." In support of this amended title, Applicants enclose copies of an Office Action dated October 23, 2002, wherein the Examiner requested a more descriptive title; Amendment and Response dated January 21, 2003, requesting

entry of a new title; and Final Office Action, dated April 21, 2003, wherein Examiner acknowledges new title of invention.

Respectfully submitted,

Dated: January 12, 2003

By: Richard J. Stern
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/828,995 | 04/09/2001 | Catherine A. McCall | AL-7 | 9579 |

26949 7590 10/23/2002

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EXAMINER

SPECTOR, LORRAINE

ART UNIT PAPER NUMBER

1647

DATE MAILED: 10/23/2002

'02 OCT 28 RCV'D

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action
3 mo response due Jan 23, 2003
w/ extensions to Apr. 23, 2003

DOCKETED

Part III: Detailed Office Action

Notice: Effective June 18, 2000, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit **1647**.

5

Restriction Requirement:

Two restriction requirements were made in this application, see paper number 14.

In response to the first, Applicant's election of Invention I in Paper No. 15, filed 8/15/02, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors 10 in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

In response to the second, requiring applicants to elect among sequences, the Examiner spoke with applicant's attorney, Richard J. Stern, by telephone in August, 2002, requesting a clearer alignment of the various sequences. The attorney complied, supporting the arguments made in paper 15 number 15 that examination of the claimed sequences would not present an undue burden. This argument is therefore, persuasive, and the second restriction requirement is **withdrawn**.

Claims 34 and 35 are rejoined with the elected group, as not presenting an undue search burden. Claims 53 and 54 are withdrawn from further consideration as being drawn to a non-elected 20 invention. Claims 24, 25, 28-30, 34-40, 43-47 and 49-51 are under consideration.

Formal Matters:

The information disclosure statements submitted 8/23/01, 10/5/01 and 2/20/02. References by Kazuhiko et al. and Avery et al. have not been considered because they are merely sequences, 25 the significance of which cannot be assessed in the absence of an alignment to the claimed sequences or alternatively a statement of relevance.

The title of the invention is not descriptive. A new title is required that is clearly indicative



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26949 7590 04/21/2003
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EXAMINER

SPECTOR, LORRAINE

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 04/21/2003

18

'03 APR 24 RCV'D

Please find below and/or attached an Office communication concerning this application or proceeding.

Faxed OA
2 mo response due 6/21/03
" " 7/21/03
3 " w/ exts to 10/21/03

Part III: Detailed Office Action

Newly submitted claims 60-80 are pending.

Formal Matters:

5 The new title of the invention is acknowledged.

Objections and Rejections under 35 U.S.C. §112:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

10 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 75-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15 Claim 75 is indefinite as it is not clear whether "a canine IL-13R α 2 protein domain" is intended to indicate that the entire IL-13R α 2 is a domain of the fusion protein, or alternatively that only one (of several) domains of IL-13R α 2 is present in the fusion protein. Claim 75 is also indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim says only that part (b) encodes a canine IL-13R α 2 protein domain, without any structural limitations. The specification as filed discloses two proteins, 20 designated IL-13R α 1 and IL-13R α 2. Although the two presumably have different sequences and properties, the specification does not provide an adequate written description of the identifying features of the two, i.e. what would make a protein an IL-13R α 1 and not an IL-13R α 2, or vice versa, or even features that would distinguish either from other proteins. Thus, the metes and bounds of claim 75 cannot be determined, as the protein is referred to only by name, and as the specification 25 fails to breath life and meaning into that name.

The remaining claims are rejected for depending from an indefinite claim.

The following is a quotation of the first paragraph of 35 U.S.C. 112: